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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,426	06/15/2001	Hugh Boyd Morrison	RCA 89186	1414

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EXAMINER
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SHANNON, MICHAEL R

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/868,426

Applicant(s)

MORRISON ET AL.

Examiner

Michael R. Shannon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed July 29, 2005 have been fully considered but they are not persuasive.

#### Arguments relating to the Rejection of claim 1 under 35 USC §103(a)

The argument relating to the video processing apparatus and its interpretation as either being drawn to the central processing system 334 or the recording device 336 [page 6, lines 4-21] is not persuasive. Firstly, the Examiner originally pointed out that the central processing system 334 and the recording device 336 of Blake (WO 98/10589) together meet the claimed video processing apparatus. Nowhere in the Office Action dated April 28, 2005 was it suggested that either the central processing system 334 or the recording device 336 alone met the video processing apparatus. Both the central processing system and the recording device were discussed together as meeting the claimed video processing apparatus. In regards to standard case law, it has been held that forming in one piece an article which has formerly been formed in two pieces, and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). In other words, it would have been clearly obvious to one of ordinary skill in the art to make the central processing system 334 and the recording device 336 of Blake integral parts to perform the claimed functionality of the video processing apparatus.

Furthermore, on page 6, line 24 – page 7, line 3, the Applicant states, “LaJoie does not disclose or suggest that the set-top box can remotely receive an electronic

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message comprising information relating to time and channel data of a selected event, and, this, does not disclose or suggest the processing step.” The Examiner must agree, and in fact, never opined that the LaJoie reference disclosed the processing step. In fact, the Examiner clearly stated that the processing step was met by Blake, page 17, lines 10-15.

The Applicant further argues that “LaJoie does not disclose or suggest that the set-top box can forward an electronic message, as recited in amended claim 1” [Remarks, page 7, lines 3-5]. The Examiner contends that while neither LaJoie nor Blake are specific with regards to the forwarding of an electronic message, the two taken in combination suggest that the notification of a conflict (as taught by LaJoie) would be implemented using e-mail correspondence (as taught by Blake) by forwarding an electronic notification message. LaJoie clearly recognizes the need to notify a user when a conflict of recordings occurs. Since the user of Blake is remotely located, it would only seem reasonable to notify the remote user in the same manner as that user communicates with the system (such as e-mail as disclosed on page 18, line 28 of Blake).

Arguments relating to the rejection of claims 2-8 under 35 USC §103(a)

The Applicant states, “Blake does not disclose that an operating command is included in the subject of the e-mail. Macrae also does not disclose that an operating command for operating a video processing apparatus is include[d] in the subject field of the e-mail, even though Macrae discloses that an e-mail must include a subject field” [page 8, lines 11-15]. As the Applicant admits, Macrae discloses that an e-mail

message must include a subject field. Also, the Blake reference discloses receiving messages directly from a user in email format with control information [page 18, lines 20-30]. The Examiner contends that just like it would have been obvious to have an e-mail with sender and subject information, it would also have been obvious to have the subject information contain the operating command. The Examiner contends that since the Blake reference states "the user may enter the starting time, ending time, channel, date, and time information directly" [page 17, lines 15-16] and that the "user may also send recording requests via e-mail" [page 18, lines 27-28], that it would have been clearly obvious to place the request in any section of the e-mail message, such as the subject. While it is not directly disclosed, the subject line of the e-mail message is arbitrary and can contain anything that the user desires, therefore, placing the operating command in the subject versus placing it in the body is totally up to the discretion of the user and since Blake is silent as to the configuration of the e-mail message, common knowledge suggests that the operating command could be placed in the subject line, as would be obvious to one of ordinary skill in the art.

Finally, the Applicant argues, "Nowhere do Blake and Macrae disclose or suggest that the message portion of an email comprises a password" [page 9, lines 1-2]. The Examiner must respectfully disagree. Although it is not expressly taught by the Blake reference, the inherent teaching of a password is very clear. The Blake reference teaches that the user must log on to the central processing system 334 and that the user may send a recording request via e-mail to an account connected to processing system 334 [page 18, lines 23-29]. In order to log on to an account a user must

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inherently possesses a password. Since the logging on is being done via an e-mail request, this inherently teaches that the password must be contained within the e-mail message. Therefore, the fact that the email message comprises a password is very well met by this inherent teaching of a password for logging on to an account via sending an email.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blake et al (WO 98/10589), previously cited by Examiner, in view of LaJoie et al (USPN 6,772,433), previously cited by Examiner.

Regarding Claim 1, Blake shows a method for operating a video processing apparatus comprising receiving by said video processing apparatus an electronic message remotely (page 17 lines 5-12, page 18 lines 20-30, sending message from remote location), said electronic message comprising information relating to time and channel data of a selected event (page 17 lines 9-11, channel and time data), and processing said electronic message in said video processing apparatus to determine said time and channel of the selected event (page 17 lines 10-15, processing system determines to which program the code corresponds). Blake fails to show forwarding by

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said video processing apparatus another electronic message if there is a conflict between said time and channel data and a preexisting timer event. LaJoie shows the ability to notify a user if there is a conflict between the time and channel data and a preexisting event (col. 21 lines 43-67, col. 29 lines 30-46, conflict checking and notification feature). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Blake with the conflict management of LaJoie so that a user would be notified of possible program conflicts and would not erase over other shows. LaJoie clearly recognizes the need to notify a user when a conflict of recordings occurs. Since the user of Blake is remotely located, it would only seem reasonable to notify the remote user in the same manner as that user communicates with the system (such as e-mail as disclosed on page 18, line 28 of Blake).

Regarding claim 9, Blake shows logging onto an account (page 18 lines 24-29, log on to account). Because a user must supply some sort of identifying information to successfully log on to a remote account, there is a data "password." In order to log on to an account a user must inherently possess a password. Since the logging on is being done via an e-mail request, this inherently teaches that the password must be contained within the e-mail message. Therefore, the fact that the email message comprises a password is very well met by this inherent teaching of a password for logging on to an account via sending an email.

4. Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blake et al (WO 98/10589), previously cited by Examiner, in view of Macrae et al (USPN 2004/0103439), previously cited by Examiner.

Regarding Claim 2, Blake shows a method comprising receiving a message directly from a user in email format including control information (page 18 lines 20-30, user send recording requests via email), processing, in said video processing apparatus, said message to determine said control information (page 18 lines 19-25, processing system receives control information), and operating said video processing apparatus in response to said operating command and said control information (page 18 lines 19-25, processing system activates recording device). Blake fails to show that the email message contains subject and sender information. Macrae shows that email messages normally contain subject and sender information (page 6 section 0055, viewer may view the subject or sender of the message). Furthermore, as discussed above, Blake fails to explicitly disclose that the subject comprises an operating command for operating said video processing apparatus. While it is not directly disclosed, the subject line of the e-mail message is arbitrary and can contain anything that the user desires, therefore, placing the operating command in the subject versus placing it in the body is totally up to the discretion of the user and since Blake is silent as to the configuration of the e-mail message, common knowledge suggests that the operating command could be placed in the subject line, as would be obvious to one of ordinary skill in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Blake with the ability to receive emails with sender and subject information as



shown in Macrae so that the system would know who sent the command message, as well as other pertinent data.

Regarding Claim 3, Blake shows channel data and time data (page 18 lines 20-23, program, time, and channel data). Blake further shows logging onto an account (page 18 lines 24-29, log on to account). Because a user must supply some sort of identifying information to successfully log on to a remote account, there is a data "password." In order to log on to an account a user must inherently possess a password. Since the logging on is being done via an e-mail request, this inherently teaches that the password must be contained within the e-mail message. Therefore, the fact that the email message comprises a password is very well met by this inherent teaching of a password for logging on to an account via sending an email.

Regarding Claim 4, Blake shows evaluating the user log on for verification (page 18 lines 24-29, log on to account and confirming user input data) and turning on said video processing apparatus at the desired time and selecting a program in response to the sent data (page 18 lines 25-26, activating recording device at appropriate time to record appropriate program).

Regarding Claim 5, Blake shows a recording command and said step of operating comprises controlling a video recording device, interconnected thereto, to record a program associated with said time and channel data (page 18 lines 25-26, activating recording device at appropriate time to record appropriate program).

Regarding Claim 6, Blake shows programming an event timer, associated with said video recording device, using said time and channel data (page 16 lines

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26-32, scheduler that checks time and date slots, page 17 lines 10-15, storing appropriate time, date, and channel and activating recording).

Regarding Claim 7, Blake shows that the control information comprises program data (page 18 lines 20-25, program code, start time, end time, channel, date, title, or theme).

Regarding Claim 8, Blake shows passing the data to the electronic program guide to determine the time and channel information associated with said program data, said program data corresponding to a program listed in said electronic program guide (page 16 lines 26-32, schedule data structure, page 17 lines 10-14, upon receiving code, processing system determines which program the code refers to from schedule).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. Ellis et al (USPN 2005/0028208) disclose an interactive television program guide with remote access.
  - b. Marolda (USPN 2003/0009766), while not necessarily prior art, discloses person-to-person scheduling and notification of automatic program recording for personalized television. This system is very similar to the claimed invention.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Shannon who can be reached at (571) 272-7356 or Michael.Shannon@uspto.gov. The examiner can normally be reached by phone Monday through Friday 8:00 AM – 5:00PM, with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (571) 272-7353.

**Any response to this action should be mailed to:**

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Effective January 14, 2005, except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

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Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **(571) 272-2600**.

Michael R Shannon  
Examiner  
Art Unit 2614

Michael R Shannon  
November 9, 2005



JOHN MILLER  
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